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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,585	02/08/2002	Marek Kwiatkowski	11989-008001	2835

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FISH & RICHARDSON P.C.  
PO BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/071,585	KWIATKOWSKI, MAREK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frank W Lu	1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 32-35 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,10-13,18,20-23,29,32 and 33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,6-9,14-17,19,24-26,34 and 35 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's response to the office action filed on November 18, 2005 has been entered. The claims pending in this application are claims 1-29 and 32-35 wherein claims 4, 5, 10-13, 18, 20-23, 29, 32, and 33 have been withdrawn due to species election. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of amendment filed on June 13, 2005.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 6-9, 14-17, 19, 24—28, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1 and 27 are rejected as vague and indefinite. Since the claims do not require that non-bifunctional oligonucleotides adhere to said separation medium, it is unclear how to elute the non-bifunctional oligonucleotides as recited in step c) of claim 1 and steps c) and e) of claim 27.

5. Claim 26 is rejected as vague and indefinite. Since step d) of the claim requires only cleaving either said first separation tag or said second separation tag, it is unclear how to elute an oligonucleotide lacking said first separation tag and an oligonucleotide lacking said second separation tag in the same time as recited in step e) of the claim. Please clarify.

***Response to Arguments***

In page 7, second paragraph bridging to page 8, second paragraph of applicant's remarks, applicant argues "[S]tep (e) does not recite eluting two different oligonucleotides, one lacking the first separation tag and one lacking the second separation tag. Rather, step (e) of claim 26 recites eluting an oligonucleotide lacking the first separation tag and the second separation tag. Thus, the oligonucleotide eluted in step (e) lacks both separation tags. It is possible to elute an oligonucleotide lacking both separation tags in step (e) of claim 26 because the plurality of oligonucleotides recited in claim 1 includes both bifunctional and non-bifunctional (e.g., monofunctional) oligonucleotides. Thus, both bifunctional and monofunctional oligonucleotides can be attached to the separation medium. Cleaving the separation tag from a monofunctional oligonucleotide in step (d) of claim 26 will result in an oligonucleotide that lacks both separation tags. This oligonucleotide can be eluted in step (e) of claim 26".

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because claims 1 and 26 do not require that non-bifunctional oligonucleotides adhere to said separation medium, it is unclear how to elute the non-bifunctional oligonucleotides as argued by applicant.

6. Claim 27 is rejected as vague and indefinite. If step a) only has one non-bifunctional oligonucleotide, how the claim can perform steps c) and e) together in the same method. Please clarify.

7. Claim 34 recites the limitation "said oligonucleotide" in the claim. There is insufficient antecedent basis for this limitation in the claim because there is no word "oligonucleotide" in the step f). Please clarify.

***Conclusion***

8. No claim is allowed.
9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Frank Lu  
Primary Examiner  
February 21, 2006



*Primary* **FRANK LU**  
**PATENT EXAMINER**